

REMARKS/ARGUMENTS

The claims are 1, 2, 4-6 and 9-10. Claims 1 and 6 have been amended to better define the invention and to incorporate subject matter previously appearing in claim 3 and 8. Accordingly, claims 3 and 8 have been canceled, and claims 4 and 5, which previously depended on claim 3, have been amended to depend on claim 1. Claim 6 has also been amended to incorporate the subject matter of claim 7. Accordingly, claim 7 has also been canceled. Support for the claims may be found, inter alia, in the disclosure in the paragraph bridging pages 6 and 7 and FIG. 4. Reconsideration is expressly requested.

Claims 1-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lyons, III et al.* U.S. Patent No. 5,263,967 in view of *Chin* U.S. Patent No. 4,452,244. Essentially, the Examiner's position is (1) that *Lyons, III et al.* discloses the laparoscopic instrument and method recited in the claims except for each jaw having a respective roller mounted thereon for free rotational movement, (2) that *Chin* discloses this feature, and (3) that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the jaws of

Lyons III et al. by substituting the jaws including rollers as taught by Chin in order to move the roller clamped instrument along the artery to strip the core of plaque from the artery and enable its removal through incision.

This rejection is respectfully traversed.

As set forth in claims 1 and 6, as amended, Applicant's invention provides a laparoscopic instrument and a method using a laparoscopic instrument to propel a foreign body along an anatomical duct in order to remove the foreign body. The laparoscopic instrument includes an elongated body having a diameter less than 5 mm so that it may be inserted into a patient via a trocar and an operative tip including first and second jaws having a respective roller mounted on each jaw for free rotational movement. A respective pair of thrust washers is disposed on each shaft portion of the jaw on the proximal and distal side of the rollers, and a respective cap fitting secures the roller on the shaft portion through the distal thrust washer, which minimize friction between rollers and shaft. In this way, and as specifically recited in claim 6, as amended, a foreign

body may be propelled along an anatomical duct safely without excessive pressure so as to damage the duct.

None of the cited references discloses or suggest a laparoscopic instrument or a method for propelling a foreign body along an anatomical duct using a laparoscopic instrument which has an elongated body with a diameter less than 5 mm, rollers mounted on jaws of an operative tip for free rotational movement, and a respective pair of thrust washers disposed on either end of the rollers so that foreign bodies may be safely propelled along the duct.

The primary reference to *Lyons III et al.* discloses a medical instrument with a dual action drive having end effectors such as jaws that can open and close; however, there is no disclosure or suggestion of providing the jaws with rollers for free rotational movement so that a foreign body may be safely propelled along a duct.

The defects and deficiencies of *Lyons III et al.* are nowhere remedied by the secondary reference to *Chin*. *Chin* discloses an endarterectomy roller that is provided with disposable roller

elements. This device is entirely unsuitable for being inserted through a laparoscopic trocar. Moreover, there is no disclosure or suggestion of providing the rollers with a respective pair of thrust washers so as to minimize friction between the rollers and shaft. Thus, even if *Chin's* rollers were somehow placed on the *Lyons III, et al.* instrument, friction would prevent the rollers from being freely rotatable and make the hypothetical combination entirely unsuitable for use to propel foreign bodies along a duct such as a common duct, a cystic duct, a biliary duct or an ureter.

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art..." 35 U.S.C. §103(a). As instructed by the Federal Circuit *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1616-17 (Fed. Cir. 1999), the phrase "at the time the invention was made" guards against entry into the tempting but forbidden zone of hindsight. Thus,

"Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is expressly important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome where that which only the inventor taught is used against its teacher.'"

50 U.S.P.Q.2d at 1617 (citations omitted).

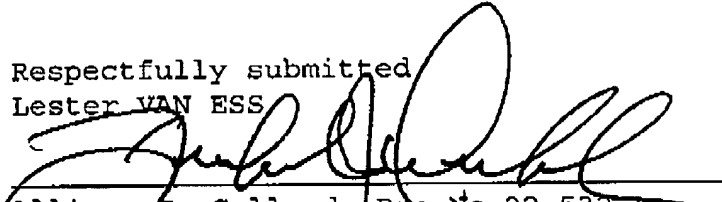
It is respectfully submitted that in the combination of *Lyons III et al.* with *Chin*, the Examiner is engaging in an impermissible retrospective view with knowledge of the invention in which the Examiner combines these references where one skilled in the art would have no reason to do so as *Chin* relates to an instrument having a completely different purpose than that to which Applicant's invention is directed. In this connection, it should be noted that although *Chin* issued in 1984, nowhere is there any disclosure or suggestion in the subsequent *Lyons III et al.* patent that rollers could be applied to the end effectuators

of their instrument. Accordingly, it is respectfully submitted that Applicant's invention as recited in claims 1 and 6, as amended, and the dependent claims 2, 4, 5 and 9-10, is patentable over the cited references.

In summary, claims 1 and 4-6 have been amended, and claims 3, 7 and 8 have been canceled. In view of the foregoing, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Respectfully submitted  
Lester VAN ESS

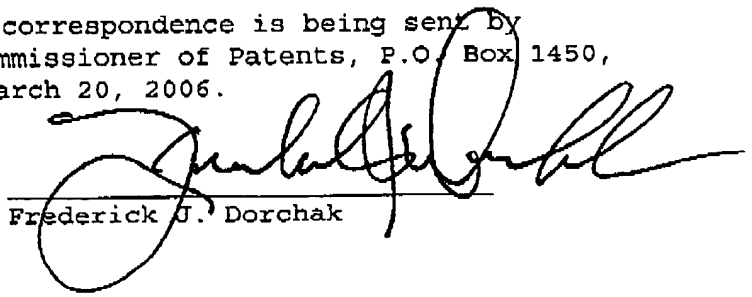
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